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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,955	01/25/2001	Stephen R. Carlson	CARLSON#1(CIP)(CIP)	9807

7590 11/10/2003

W. Edward Johansen
11661 San Vicente Boulevard
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EXAMINER

KLEBE, GERALD B

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,955

Applicant(s)

CARLSON, STEPHEN R.

Examiner

Gerald B. Klebe

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment

1. Acknowledgment is given to applicant's claim for priority based on continuation from earlier applications

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

3. The application has been filed with informal drawings which are suitable for examination purposes. However, formal drawings will be required when the application is allowed.

In Figure 3, the rightmost numeric 39 is shown without a designator line.

Correction is required.

Specification

4. The disclosure is objected to because of the following informalities:
page 20, lines 15-16, in referring Figs 1-3 identifies bar 30; there is no item 30 designated in these figures. Clarification or correction is required.

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Claims Rejections – 35 U.S.C. Sec. 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillis (US 5433636) in view of Harris (US 4871337).

a. Gillis discloses a combination skiboard, binding and mount (Fig 1, item 20; and refer col 1, lines 52-54 and col 2, lines 41-43) comprising:

- a skiboard (22) having a centerline wherein the skiboard has a channel (30) longitudinally extending along the centerline;
- a binding base plate (130) disposed on the skiboard;
- a disc body (110) being rotatably coupled to the binding base plate; and
- a locking mechanism (combination of 120 and 122; refer col 3, line 67 to col 4, line 11) for securing locking the disc and base plate to the board.

b. Gillis locks the disc directly to the channel in the board, rather than using a metal rail disposed in the channel. Note also, Gillis discloses that skiboards and snowboards are analogous and that similar problems exist between the two (refer cols 1-2, under "Background of the Invention").

c. However, Harris teaches a snowboard, binding, and mount, (refer col 1, lines 61-67) the snowboard having a longitudinal channel (28) along its centerline and disposed therein

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and a flexible metal rail fixedly coupled into the channel, the rail having a key-slot (30) and two series of parallel notches (38; refer Figs 3 and 4, and col 3, lines 3-7).

d. It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the skiboard, binding, and mount of Gillis by incorporating the flexible metal rail of Harris in order to provide an interchangeable channel more resistant to wear than the board material and replaceable when unduly during lifecycle maintenance.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,189,899 B1.

a. Since the claim recitation of the instant application as regards the rotatable disc and its connection to the board is more broadly stated than it is in the claim language of the reference patent in regard to the limitations of the rotatable disc element, it is clear that the limitations of the claim of the instant application, being more broadly recited, and thus included

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in the claim recitations of the reference patent, are already provided the protection of the reference patent. Furthermore, there is no apparent reason why applicant was prevented from presenting a claim corresponding to that of the instant application during prosecution of the application which matured into a patent; and

b. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences, identified below, represent obvious modifications that one of ordinary skill in the art at the time the invention was made would have been able to discover based on routine experimentation to determine the optimal or working ranges recited in the limitations of the instant invention. In particular, the claim of the instant application in referring to the rotatable disc recites "... a disc being rotatably coupled to said binding base plate...", whereas the reference patent claim 1, subpara. d. relative to the disc recites the further limitations of the "...disc having a center-line and a bottom surface on which a bar is disposed about said center-line thereof and fixedly coupled thereto whereby said bar engages and opposing pair of said series of parallel notches of said rail, said disc being rotatably coupled to said binding base plate...". These recitations of the reference patent as related to the connection of the disc to the board via its connection with the rail, represents simply an additional structural element that the claim of the instant application does not recite but which would have been obvious to one having ordinary skill in the art at the time the instant invention was made to have incorporated an additional structural element, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184. Regarding the recitation of the claim of the reference patent "...whereby said bar engages an opposing pair of said series of parallel notches of said rail..." it has been held that the functional "whereby" statement does not define any structure and accordingly an not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

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Response to Argument


9. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.

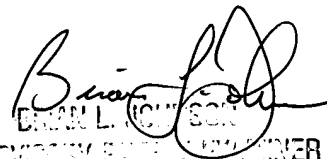
Conclusion

10. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, facsimile 703-872-9306, 8:00 AM- 4:30 PM ET, Mon.- Fri., or to Supervisory Patent Examiner Brian L. Johnson, Art Unit 3618, at 703-308-0885.

Note that the examiner's fax number has changed.

Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.


gbklebe / AU 3618 / 29 October 2003


BRIAN L. JOHNSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600 10/31/03